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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/732,293

12/08/2000

Timo Hanninen

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02/02/2006

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TYSONS CORNER, VA 22182

EXAMINER

HSU, ALPUS

ART UNIT

PAPER NUMBER

2665

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/732,293	<b>Applicant(s)</b> HANNINEN ET AL.	
	<b>Examiner</b> Alpus H. Hsu	<b>Art Unit</b> 2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 23-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 23-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 23, 26, 30, 37 and 38, it is confusing for reciting “an initiation of a call” (claim 23) or “an initiation of a channel” (claims 26, 30, 37 and 38) inconsistently. Which claim language is intended to be the claim limitation?

In addition, in claim 23, line 7, “form” should read as -- from --.

In claim 30, line 4, “a single communication” should be changed to -- a single communication channel --.

2. Claims 23-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claimed features of “A network for communicating with a plurality of radiotelephones via respective communication channels over a carrier, wherein the channels can operate at a first or second data rate such that the carrier can transmit a single communication channel operating at the first data rate or two communication channels operating at the second data rate, the network comprising a controller responsive to **an initiation of a call with a second network** for initiating a change in the data rate of a transmitted channel from the first data rate to the second data rate.” as in claim 23, “A controller for operation in a network wherein the network communicates with a plurality of radiotelephones via respective communication channels over a carrier, the channels being operable at a first or second data rate such that the

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carrier can transmit a single communication operating at the first data rate or two communication channels operating at the second data rate, the controller comprising means responsive to **an initiation of a channel with a second network** for initiating a change in the data rate of a transmitted channel from the first data rate to the second data rate.” as in claim 30, and “A method of communicating with a plurality of radiotelephones via respective communication channels over a carrier, wherein the channels can operate at a first or second data rate such that the carrier can transmit a single communication channel operating at the first data rate or two communication channels operating at the second data rate, the method comprising changing the data rate in response to **an initiation of a channel with a second network**.” as in claim 38, were not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

To be more specific, it is **not** fully disclosed as to what “**an initiation of a call or a channel with a second network**” is referring to. Is it referring to a subscriber in the first network calling a subscriber in the second network, or the other way around? It is also unclear as to what is the purpose for “initiating a change in the data rate of **a transmitted channel** from the first data rate to the second data rate in response to **an initiation of a call or a channel with a second network**”. Is it a **single** transmitted channel being changed on the data rate only? If it is, then how can the call between two subscribers in two networks be established with a **single** transmitted channel being changed?

The specification merely repeats the same recitation as in the claims (see sections [0013], [0030]) without further distinguishing between the two conditions of a subscriber in the first network calling a subscriber in the second network, or the other way around. Regarding the

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purpose of “initiating a change in the data rate of channels from the first data rate to the second data rate in response to **an initiation of a call or a channel with a second network**”, although in section [0055], lines 18-20, it describes the situation of a user on the second network wanting to establish a call with a subscriber of the first network, it requires a call request sent from the user in the second network to the controller (i.e. the gatekeeper). The controller then instructs two subscribers in the first network, each utilizes a timeslot at full speech rate, to change to half speech rate, and for the IMC 6 to combine the two half speech rate channels onto the same timeslot, to result in one of the timeslots being released, thereby allowing a call to be placed between two subscribers in two networks.

The claims **23-36, 38-41** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement because nowhere in the disclosure described the claimed subject matter as claimed in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Furthermore, the claimed feature of “A radiotelephone for operation with a network which initiates a change in data rate of a channel from a first data rate to a second data rate in response to an initiation of a channel with a second network, **the radiotelephone comprising a controller** responsive to a signal from the network for changing the data rate of data being transmitted on a channel from a radiotelephone” as in claim **37**, was not described in the disclosure at all. In fact, it is the controller 7 (i.e. gatekeeper) that is disclosed, which is connected to BTS 5, and then the BTS 5 is connected to the radiotelephone 4 via an air interface. There is **nowhere** in the disclosure describes that **the controller is located within the**

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**radiotelephone** to change the data rate of data being transmitted on a channel from a radiotelephone responsive to a signal from the network.

3. In view of the above 112, 1<sup>st</sup> paragraph problems as indicated, there is no prior art rejection can be applied at this time.

4. Applicant's arguments filed November 28, 2005 have been fully considered but they are not persuasive.

In the remark, the applicant mainly argued that the 35 U.S.C. 112, first paragraph rejection regarding claims 23-41 was improper and should be withdrawn since it is the specification alone should have been rejected. The examiner disagreed since the claims contain subject matter which was not described in the specification in such a way to enable one skilled in the art to which it pertains to make and/or use the invention. The 35 U.S.C. 112, first paragraph rejection regarding claims 23-41 deems to be proper.

To be more specific, the specification fails to provide the enablement for “changing the data rate in response to **an initiation of a call or a channel with a second network**”. It is **not** fully disclosed as to what “**an initiation of a call or a channel with a second network**” is referring to. Is it referring to a subscriber in the first network calling a subscriber in the second network, or the other way around? It is also unclear as to what is the purpose for “initiating a change in the data rate of **a transmitted channel** from the first data rate to the second data rate in response to **an initiation of a call or a channel with a second network**”. Is it a **single** transmitted channel being changed on the data rate only? If it is, then how can the call between two subscribers in two networks be established with a **single** transmitted channel being changed?

The specification merely repeats the same recitation as in the claims (see sections [0013], [0030]) without further distinguishing between the two conditions of a subscriber in the first network calling a subscriber in the second network, or the other way around. Furthermore, regarding the purpose of “initiating a change in the data rate of channels from the first data rate to the second data rate in response to **an initiation of a call or a channel with a second network**”, although in section [0055], lines 18-20, it describes the situation of a user on the second network wanting to establish a call with a subscriber of the first network, it requires a call request sent from the user in the second network to the controller (i.e. the gatekeeper). The controller then instructs two subscribers in the first network, each utilizes a timeslot at full speech rate, to change to half speech rate, and for the IMC 6 to combine the two half speech rate channels onto the same timeslot, to result in one of the timeslots being released, thereby allowing a call to be placed between two subscribers in two networks.

In addition, the claimed feature of having “A radiotelephone for operation with a network which initiates a change in data rate of a channel from a first data rate to a second data rate in response to an initiation of a channel with a second network, **the radiotelephone comprising a controller** responsive to a signal from the network for changing the data rate of data being transmitted on a channel from a radiotelephone” as in claim 37, was not described in the disclosure at all. In fact, only the controller 7 (i.e. gatekeeper) was disclosed, which is connected to BTS 5, and then the BTS 5 is connected to the radiotelephone 4 via an air interface. There is **nowhere** in the disclosure describes that **the controller is located within the radiotelephone** to change the data rate of data being transmitted on a channel from a radiotelephone responsive to a signal from the network.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

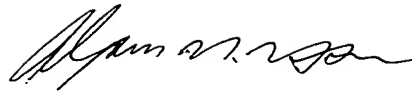
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (571)272-3146. The examiner can normally be reached on M-F (5:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D. Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AHH

A handwritten signature in black ink, appearing to read "Alpus H. Hsu".

Alpus H. Hsu  
Primary Examiner  
Art Unit 2665